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No. 09-97 (2)

Supreme Court, U.S.
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In The Supreme Court Of The United States

STEVEN D. RITCHIE, *et al.*,

Petitioners,

v.

VAST RESOURCES, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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A. Questions Presented

1. Have petitioners presented compelling reasons to revisit patent obviousness under 35 U.S.C. § 103(a) when the Federal Circuit invalidated the patent by following this Court's two-year-old ruling in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)?

2. Have petitioners presented compelling reasons to grant the petition where the purported conflict between court of appeals' decisions is from the same court, the Federal Circuit, different facts in the respective cases caused any differences in the decisions, one case applied the rule this Court rejected in *KSR*, and the decisions do not conflict?

3. Have petitioners presented compelling reasons to grant the petition simply because the Federal Circuit chose not to discuss purported evidence of commercial success, a secondary consideration of non-obviousness in its opinion holding the patent invalid as obvious?

B. Corporate Disclosure Statement Pursuant to Supreme Court Rule 29.6

Respondent Vast Resources, Inc. d.b.a. Topco Sales does not have a parent corporation, and no publically held company owns 10% of more of its stock.

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E. Introduction

Petitioners Ritchie and Reynard seek to overturn a Federal Circuit decision invalidating a patent on Pyrex[1] glass sex toys, dildos, for obviousness in view of similarly shaped sex toys that have been made of glass since the Roman Empire. Pyrex is a hard glass that is less likely to break than conventional soda-lime glass when inserted into a human orifice. The prior art also taught other Pyrex device such as thermometers inserted into human orifices.

Pyrex performs no differently in sex toys than it performs in other glass devices. Regardless of whether the use is thermometers, cookware, laboratory glass or sex toys, Pyrex resists breaking and will not crack if heated quickly.

Thus, Pyrex performs predictably for sex toys. Further, if sex toy designers were dissatisfied with soda-lime glass sex toys, they would find texts and other prior art showing properties of a limited range of different glasses. They would choose those glasses best suited for sex toys. Choosing Pyrex would be obvious to try. Thus, petitioners' patent falls within this Court's obviousness guidelines recently stated in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

Petitioners do not claim the Federal Circuit is at odds with *KSR*'s obviousness analysis. They do not allege the Federal Circuit, district courts or the

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[1] The patent claims the glass contains an oxide of boron. The Federal Circuit opinion referred to the borosilicate glass as Pyrex, and respondent does the same here.

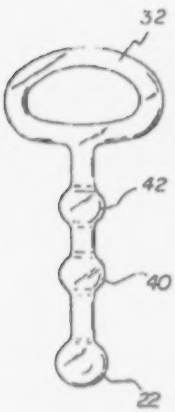
Patent and Trademark Office (PTO) need added guidance for obviousness rulings. Therefore, they show no compelling reason why this Court must involve itself. Petitioners complain that the Court in *KSR* discussed more factors to reach its obviousness conclusion than the Federal Circuit mentioned here. However, appellate courts can fashion their own opinions without exhaustively discussing every issue each party raises.

Petitioners' main criticism rests with the Federal Circuit's failure to weigh purported commercial success as heavily as petitioners want. Petitioners did not establish commercial success. Moreover, the Court rarely grants certiorari merely to correct facts. S. Ct. R. 10.

In the past 65 years, this Court eight times rejected patent holders' attempts to use alleged commercial success to save patents invalid for obviousness. Only one, *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275 (1944), upheld the patent, but even there commercial success was only one factor and was relevant only because it was "a *close case*." *Id.* at 279 (emphasis added). The other cases rejected commercial success evidence with language such as "commercial success 'without invention will not make patentability.'" *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969) (quoting *Great Atl. & Pac. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 153 (1950)) ("*A&P*").

F. Statement of the Case

Petitioners Reissue Patent No. 38,928 (the '928 patent) titled "Sex Aid," shows several designs for glass sex toys. None has moving parts. One patent drawing is shown below:



Petitioners sued respondent Vast Resources, Inc. (d.b.a. Topco Sales) ("Topco")[2] for infringement, alleging 14 Topco Pyrex products infringed. Topco asserted defenses of non-infringement, invalidity based upon obviousness, lack of enablement, failure to disclose the best mode and indefiniteness under § 112,[3] and new matter under § 132. Topco also maintained the patent was unenforceable because the patentees intentionally withheld material prior art from the PTO.

Petitioners asserted several apparatus claims and several method claims. The apparatus claim used what the Federal Circuit called "troublesome" language, *Ritchie v. Vast Resources, Inc.*, 563 F.3d 1334, 1336 (Fed. Cir. 2009), which the court held claimed a Pyrex sex toy:

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[2] Respondent is known in the trade as "Topco," and the trial court also used "Topco." Although the petition refers to respondent as "VRI," this opposition uses "Topco."

[3] Unless stated otherwise, all statutory references are to Title 35 of the United States Code.

> 2. A sexual aid comprising:
>
> a solid rod having a length with a first end and a second end constituting a gripping area; and
>
> a spherical enlargement integrally formed in the first end of the rod, the rod and enlargement being fabricated of a generally lubricious glass-based material containing an appreciable amount of an oxide of boron to render it lubricious and resistant to heat, chemicals, electricity and bacterial absorption, with the rod having a bend within its length between the gripping area and the first end having the spherical enlargement.

Pet. App. B, pp. 11a-12a. The method claims begin, "A method of using a sex aid to increase stimulation...." *Id.* p. 12a. Petitioners did not claim Topco practiced the method but contended Topco induced persons buying or using Topco's accused products to infringe.

After a bench trial, the court held the patent not invalid and held only three of the 14 accused Topco products infringed the apparatus claim, and ten (including the first three) infringed the method claim by inducement only. Thus, four did not infringe. The trial court awarded no lost-profit or reasonable royalty damages for lack of proof, and it permanently enjoined Topco.

Petitioners appealed the failure to award damages. They did not appeal the holding that 11 accused Topco products failed to infringe the apparatus claim.

Topco cross-appealed on invalidity (obviousness and lacking enablement). On infringement, Topco argued the trial court misinterpreted claim terms that it had determined differently before trial, or the court incorrectly applied those construed claims. Topco also urged that the trial court misapplied inducing law and this Court's injunction ruling in *eBay Inc. v. MercExchange, LLC*, 457 U.S. 388 (2006). The Federal Circuit stayed the injunction pending appeal.

The terse Federal Circuit opinion (Posner, J, by designation) dealt with one issue only—obviousness. The following quotations correctly applied obviousness law per *KSR*:

> Among the inventions that the law deems obvious are those modest, routine, everyday, incremental improvements of an existing product or process that confer commercial value (otherwise they would not be undertaken) but do not involve sufficient inventiveness to merit patent protection. This class of inventions is well illustrated by efforts at routine experimentation with different standard grades of a material used in a product—standard in the sense that

> their properties, composition, and method of creation are well known, making successful results of the experimentation predictable. This is such a case.

Ritchie, 563 F.3d at 1337.

> The plaintiffs' patent, however, with its vague reference to "appreciable amounts" of oxide of boron, does not claim any variant of off-the-shelf borosilicate glass. And since that is a standard product with well-known properties—including the properties listed in the patent—to experiment with substituting borosilicate glass for ordinary glass in a sexual device was not a venture into the unknown.

Id.

> This case thus exemplifies the Supreme Court's analysis in *KSR* .... "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar

> devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

Id. (citation omitted; quoting *KSR*, 550 U.S. at 417).

> And if more is required to make our point, there is the venerable case of *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 ... (1851), cited approvingly in *KSR* ..., 550 U.S. at 406, 415, which denied patentability to an invention consisting of the substitution of a clay or porcelain knob for a metallic or wood knob in a doorknob (the doorknob itself, as distinct from the knob on the end of it, being an assemblage of knob, shank, and spindle).

Id. at 1337-38.

G. Petitioners Failed to Show Compelling Reasons for Granting Certiorari

1. *The Court of Appeals Followed KSR and this Court's Other Commercial Success Precedent*

Petitioners argue that the Federal Circuit ignored or gave insufficient weight to commercial success. This Court consistently treats commercial success and other considerations as "secondary," which "might be utilized." *See, e.g., Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) ("[S]econdary considerations [such] as commercial success, long

felt but unsolved needs, [and] failure of others might be utilized ...").

From *KSR* back in time, the results were the same. In *KSR*, the trial court on summary judgment held the patent invalid for obviousness, and "the secondary factor of Teleflex's commercial success with pedals based on [the inventor's] design did not alter its conclusion." *KSR*, 550 U.S. at 413. Accordingly, Teleflex's declarations did not "prevent[] the District Court from reaching the careful conclusions underlying its order for summary judgment in this case." *Id.* at 427.

Eleven years earlier, *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976) (before the Federal Circuit's creation), invalidated a barn cleaning patent. The district court held:

> [E]ven if the combination filled a "long-felt want and... has enjoyed commercial success, those matters, without invention, will not make patentability." ... "[T]o those skilled in the art, the use of the old elements in combination was not an invention by the obvious-nonobvious standard. Even though the dairy barn in question attains the posture of a successful venture, more than that is needed for invention."

Id. at 278-79. This Court agreed. "Though doubtless a matter of great convenience, producing a desired result in a cheaper and faster way, and enjoying

commercial success, Dairy Establishment did not produce a new or different function... within the test of validity of combination patents. These desirable benefits without invention will not make patentability." *Id.* at 282-83 (citations and internal quotation marks omitted).

Six years earlier, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), held a paving machine patent invalid as obvious. The machine simply combined four features from the prior art into a single machine. The patent holder "fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters without invention will not make patentability." *Id.* at 61 (internal quotation marks omitted).

In *Graham* in 1964, the patent holder alleged, "[T]he long-felt need in the industry for a device such as [the inventor's] together with its wide commercial success supports its patentability." *Graham*, 383 U.S. at 35. This court still held the patent obvious. *Id.* at 36.[4]

Continuing back in time to *A&P* in 1950, the invention, a rolling frame to pull groceries to supermarket cashiers, "filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability." *A&P*, 340 U.S. at 153. Likewise, in *Jungersen v. Ostby & Barton Co.*, 335 U.S. 560

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[4] *Graham* dealt with two appeals. Secondary considerations were mentioned only in the second appeal, the *Calmar, Inc. v. Cook Chemical Co.* portion.

(1949), the patent holder granted many licenses, and the invention was a commercial success. Nevertheless, "Where, as here, however, invention is plainly lacking, commercial success cannot fill the void. ... Commercial success is really a makeweight where the patentability question is close." *Id.* at 568.

Similarly, *General Elec. Co. v. Jewel Incandescent Lamp Co.*, 326 U.S. 242, 247-249 (1945), held a light bulb coating patent invalid for lacking invention despite commercial success. Along the same vein, "He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve." *Dow Chem. Co. v. Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 328 (1945). The patent holder claimed its "process has filled a long felt want and has been a commercial success. But these considerations are relevant only in a close case where all other proof leaves the question of invention in doubt." *Id.* at 330.

Finally, this Court in *Goodyear* upheld a patent against an obviousness challenge. The patent covered an improved flashlight battery. Prior art batteries leaked and damaged the flashlights. The battery industry knew about the problem for fifty years and failed to solve it. Once the inventor made his discovery, the industry saw the merits in the invention, and the invention became commercially successful. Therefore, the failure of others and commercial success "were entitled to weight in determining whether the improvement amounted to invention and should, in a close case, tip the scales

in favor of patentability." *Goodyear*, 321 U.S. at 278-279.

2. *No Compelling Reasons Exist to Revisit This Court's Past Rulings that Evidence of Commercial Success Might Affect a Close Case Because This Case is Not Close*

Petitioners/inventors' hired glass blowers who formed sex toys using existing, commercially available Pyrex rods. They used existing glass fabrication techniques to bend the rods and form enlargements to simulate erect penises. *See Ritchie*, 563 F.3d at 1337. ("The plaintiffs' patent, however, with its vague reference to "appreciable amounts" of oxide of boron, does not claim any variant of off-the-shelf borosilicate glass."). Pyrex acted predictably. Even petitioners' technical expert admitted that Pyrex acted as expected in sex toys. Responding to the question, "In the sex aid, the borosilicate glass is performing its expected function, correct?" he answered, "The glass itself, because of the fact that it has the oxide of boron added, provides, in a scientifically expected way, each of these characteristics." A3470. Petitioner Reynard answered, "Yes" when asked, "So what you did then with your invention is you took known properties of borosilicate glass and made a sex aid out of borosilicate glass to have those properties [resistant to temperature changes], right?" A3543.

Persons of ordinary skill in glass sex toys who want to make safer glass sex toys would look through standard texts on different glasses and pick the glass with desired properties. Similarly, they could search prior patents and learn about Pyrex thermometers for inserting into human orifices. If, somehow, they did not already know about Pyrex, they would learn that Pyrex is harder than soda-lime glass and resists cracking during rapid temperature changes. Thus, it stands out as the glass of choice. At the very least, one of ordinary skill would try Pyrex, and the "fact that a combination was obvious to try might show that it was obvious under § 103." *KSR*, 550 U.S. at 421. *See also E.M. Labs., Inc. v. United States*, 80 Cust. Ct. 125, 128 (Cust. Ct. 1978) (predating patent and referring to items "made largely of borosilicate glass, which is highly resistant to temperature changes" and other products made of "borosilicate glass which is more resistant to shock than is soda-lime glass.") Regarding another alleged advantage of Pyrex in sex toys, boiling them for sterilization, that property was well known. *See Walgreen Drug Stores v. Obear-Nester Glass Co.*, 113 F.2d 956, 963 (8th Cir. 1940) (Trademark suit dealing with glass nursing bottles recognizing that the "bottles were made of Pyrex glass so that they might be heated without injury.").

Substituting known materials in existing devices to obtain the materials' properties has been classic obviousness for at least 150 years since *Hotchkiss*, 52 U.S. (11 How.) at 266, as the Federal Circuit recognized. *Ritchie*, 563 F.3d at 1337-38.

Several post-*KSR* cases including two, *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008), and *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), show the Federal Circuit holding even substantial evidence of commercial success or other secondary considerations will not overcome strong showings of obviousness. The Federal Circuit here followed this Court's obviousness rulings over the past 65 years.

3. *No Compelling Reasons Exist to Examine the Federal Circuit's Treatment of Commercial Success Because Petitioners Failed to Show Commercial Success*

The Federal Circuit has long required patentees relying on commercial success to show a "nexus between sales and the merits of the invention." *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151 (Fed. Cir. 1983). Nexus requirements are strict. Thus, *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988), requires proof that allegedly commercially successful products read on patent claims.

Here, petitioners cannot rely on its company's products because they introduced none in evidence. The trial court held only three of 14 Topco products infringed apparatus claim 2 (Topco disputes infringement). Unless the three infringing devices had been much more successful than the non-infringing ones (they were not), the invention's merits cannot have caused any commercial success.

Petitioners also mention other companies' Pyrex sex toys, but none was before the district court, and the patent claims require more than mere Pyrex content.

The 300,000 Google hits for "glass dildo" that petitioners mention were meaningless without evidence interpreting Google search results. Therefore, the hits do not establish nexus. Further, petitioner Reynard admitted duplicate hits existed, but he did not view every entry. "I looked through the first couple of pages of entries." "I'm not sure how the counts calculated but in some cases, there would be multiple entries ...." A3073. In addition, a hit for "glass dildo" could refer to this suit, prior art and books about glass sex toys (several prior art books that use the phrase were in evidence).

The Federal Circuit requires patent holders seeking to rely on commercial success to put sales in context with sales of competing products. *Kansas Jack*, 719 F.2d at 1151 (Fed. Cir. 1983) (holding the number of units sold is irrelevant "without evidence of market share, of growth in market share, of replacing earlier units sold by others or of dollar amounts ....") Petitioners presented no such evidence.

Petitioners complain that the Federal Circuit "alluded to 'skillful marketing' to argue against commercial success." Pet. p. 8. That is not what the court did. It merely noted, "The commercial success of a product can have many causes unrelated to patentable inventiveness; for example, the commercial success of an 'invention' *might be due* not to the invention itself but to skillful marketing of the

product embodying the invention." *Ritchie*, 563 F.3d at 1336 (emphasis added). The quotation acknowledges that a patentee seeking to rely on commercial success or other secondary consideration must prove that the invention's merits, not other factors, caused any success.

> "[E]vidence of commercial success alone is not sufficient to demonstrate nonobviousness of a claimed invention. Rather, the proponent must offer proof 'that the sales were a direct result of the unique characteristics of the claimed invention—as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter.'"

In re DBC, 545 F.3d 1373, 1384 (Fed. Cir. 2008) (citation omitted and holding $130 million in sales in two years did not support commercial success nexus).

Petitioners have not argued changing the burden of proof for commercial success and nexus. They also did not show a compelling reason for this Court to review the burdens.

Petitioners also mention other secondary considerations of non-obviousness. They claim the entire industry copied them. However, they introduced no evidence that the industry copied either petitioners' claimed invention or their commercial products. "Not every competing product

that arguably falls within the scope of a patent is evidence of copying. Otherwise, every infringement suit would automatically confirm the nonobviousness of the patent. Rather, copying requires the replication of a specific product." *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325.

Finally, petitioners complain that the Federal Circuit here did not discuss a problem they believe their patent solved—odor retention in prior art sex toys. However, they refer to plastic and other materials as if the prior art contained no glass toys. If glass sex toys had any problem, it was breakage. Even children, not just those of ordinary skill, know glass breaks easily. To avoid potential breakage problems, one would look to the prior art to find glass that does not break as easily. They also could look for glass devices used in human orifices such as Pyrex thermometers. Pyrex is the obvious choice for the glass.

4. *The Federal Circuit Was Not Required to Mention Every Ground that Petitioners Wanted*

Petitioners argue issues that the Federal Circuit chose not to discuss. However, no rule requires courts of appeal to discuss every issue a litigant raises. "[C]ourts of appeals should have wide latitude in their decisions of whether or how to write opinions." *Taylor v. McKeithen*, 407 U.S. 191, 194 (1972). Thus, "The failure to discuss particular contentions ... does not mean that the tribunal did not consider them in reaching its decision." *Lowder v. Dep't of Homeland Sec.*, 504 F.3d 1378, 1383 (Fed.

Cir. 2007). "That a court 'do[es] not discuss certain propositions do[es] not make the decision inadequate or suggest the . . . court failed to understand them.'" *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 901 (Fed. Cir. 1984) (*quoting Schilling v. Schwitzer-Cummins Co.*, 142 F.2d 82, 84 (D.C. Cir. 1944)). *See also United States v. Garza*, 165 F.3d 312, 314 (5th Cir. 1999) ("A litigant's right to have all issues fully considered and ruled on by the appellate court does not equate to a right to a full written opinion on every issue raised.").

Petitioners do not seek to have this Court require every appellate opinion discuss every issue that a party might raise. They seek only to require the Federal Circuit to mention some issues they raised. That position shows no compelling reason to grant certiorari. Indeed, to be consistent, petitioners would require the Federal Circuit to discuss the issues Topco raised in its cross-appeal. Petitioners neither explain how to make a workable rule nor give reasons why courts of appeals must discuss every issue simply because one party mentions it.

The Federal Circuit requires district court's findings to be "sufficiently comprehensive and pertinent to the issue in dispute to form a basis for the district court's decision." *Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1276 (Fed. Cir. 1995). *See also* FED. R. CIV. P. 52(a)(1) (requiring district courts to "find the facts specially"). Petitioners do not seek to impose the "sufficiently comprehensive" requirement on all courts of appeals' opinions. They only want the Federal Circuit to discuss all issues that they raised. As Topco showed,

no rule requires appellate courts to discuss every issue. Instead, they have "wide latitude ... whether or how to write opinions." *Taylor*, 407 U.S. at 194.

Moreover, though the Federal Circuit here may not have mentioned the problem and solution explicitly, the opinion infers the problem (potential for glass breaking inside an orifice) and the solution (harder glass—Pyrex). They are so evident anyway that the court had no reason to mention them.

5. *The Federal Circuit's Decision Here Does Not Conflict with Stratoflex, Ruiz or the Unpublished Andersen Case*

No conflict among the circuits can exist because the Federal Circuit decides all appeals from patent infringement actions. *See* 28 U.S.C. § 1295. Nevertheless, petitioners reach out for a purported conflict between the present case and earlier Federal Circuit cases where no conflict exists. The opinions merely dealt with those cases' particular facts.

> This Court grants certiorari to review Federal Circuit precedent where that court establishes a rule that might conflict with statutes or this Court's precedent. *See Cardinal Chem. Co. v. Morton Int'l, Inc.*, 505 U.S. 83, 89 (1993) (reviewing practice of vacating validity counterclaims as moot after holding patent not infringed); *Shinseki v. Sanders*, 129 S. Ct. 1696, 1705 (2009) (reviewing regularly applied, "harmless

> error" framework in appeals from Court of Appeals for Veterans Claims); *KSR*, 550 U.S. at 419 (rejecting Federal Circuit's test requiring a specific "teaching, suggestion and motivation" in the prior art to prove obviousness). Petitioners do not assert that the Federal Circuit ruling here is part of a pattern that conflicts with a statute or this Court's opinions. Thus, they fail to raise compelling reasons to grant their petition.

Petitioners claim three Federal Circuit cases allegedly conflicting with that court's decision here. In the first, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983), the district court had disregarded alleged evidence commercial success, but the Federal Circuit still upheld the district court's obviousness holding. *Id.* at 1539. Though dicta stated that trial courts should consider all evidence when deciding obviousness, it found no nexus supported the alleged secondary consideration evidence. *Id.* at 1539-40.

Stratoflex and the present case share many similarities. There, the patent solved charge buildups in tubing by using Teflon-carbon black tubing. The inventor consulted a standard text on "conductive carbon black in rubber when he began his search for a solution." *Id.* at 1535. Here, the inventors could have consulted a standard text to find the best glass for sex aids. This was unnecessary because their glass glower already had Pyrex rods and new Pyrex's properties. As

petitioners claim here, "the patent holder in *Stratoflex* claimed "commercial success is shown because: the 'entire industry' makes the tubing ...." The Federal Circuit rejected commercial success evidence because the patent holder failed to show nexus. *Id.* at 1539 ("No evidence of record establishes that tubing covered by the claims of the ... 087 patent was used in the [third party's] retrofit. It cannot therefore be given weight in respect of commercial success.").

Andersen Corp. v. Pella Corp., 2008 U.S. App. LEXIS 24087 (Fed. Cir. Nov. 19, 2008), (unpublished), *cert. denied*, 129 S. Ct. 2739 (2009), cited by petitioners, is unpublished. Therefore, it does not receive "the effect of binding precedent." FED. CIR. R. 32.1(d), The case also is not germane. In reversing a grant for summary judgment, the Federal Circuit held that a prior art reference may not "have been part of the field of invention searched" by a person in the field. *Id.* at *12. The invention claimed using a particular mesh material for window screens. The material's distributor sold it for its electromagnetic properties. The court found evidence that the material "possessed many characteristics that an ordinary skilled insect screen designer would have viewed as undesirable for an insect screen." *Id.* at *12-13. Because the evidence created a material fact issue, the Federal Circuit reversed.

The court only mentioned commercial success in passing. "[W]e need not examine the secondary obviousness factors in any depth." *Id.* at 18.

Here, the prior art included glass sex toys. Pyrex, the alleged improvement in the patent, is the glass having known, desirable properties. Likewise, prior art glass sex toys did not teach away from using Pyrex. At least at the summary judgment stage in *Andersen*, evidence that those of ordinary skill would not consider electromagnetic material for a window screen might raise a material issue to support nonobviousness.

The third case, *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), directly conflicts with *KSR*. There, the Federal Circuit remanded an obviousness holding, in part, because the trial court failed to make specific findings on "the reason, suggestion, or motivation present in the prior art, .. which clearly and particularly would lead one of ordinary skill in the art to combine screw anchors and metal brackets. *Id.* at 660. But *KSR* rejected the rigid "teaching, suggestion and motivation" test. *KSR*, 550 U.S. at 419.

On remand, the district court again held the patent invalid, and the Federal Circuit affirmed. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 (Fed. Cir. 2004) ("[T]he record also supports the district court's discounting of Chance's evidence of secondary considerations. ... [A]ny commercial success was not due to Chance's alleged unique combination, but rather due to Chance's experience ... combined with being the first large screw anchor manufacturer to enter the underpinning market.") *Id.* at 1277.

H. Conclusion

Petitioners express no compelling reasons for the Court to review obviousness in this ordinary patent infringement case. The Federal Circuit followed an unbroken line of this Court's cases on obviousness including the recent *KSR* case and the 1850s *Hotchkiss* case.

Pyrex, a known, harder replacement for soda-lime glass, performs predictably in sex toys. Therefore, replacing soda-lime glass with Pyrex is obvious.

Consequently, Topco requests that the Court deny the petition for writ of certiorari.

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